

REMARKS

Introduction:

In accordance with the foregoing, no claims have been amended or cancelled and claim 26 has been added. No new matter is being presented. Therefore, claims 21-26 are pending and reconsideration is respectfully requested.

Rejections under 35 U.S.C. § 103(a):

Claims 21-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wang et al. (U.S. Patent No. 4,863,782) in view of Eby et al. (U.S. Patent No. 6,753,066) and Schmidle et al. (U.S. Patent No. 4,491,616). These rejections are traversed.

Regarding the rejection of claim 21, claim 21 recites applying to a surface of a gelled plastic layer a first printing ink containing a first photoinitiator in a first pattern or a first design, applying a first, non-curable coating made from a plastisol or organosol over the gelled plastic layer and first printing inks, and heating a second, curable coating, the plastic layer and a substrate, wherein mechanical embossing in areas that are not disposed over the first printing ink is relaxed.

In contrast, Wang fails to disclose among other things a non-curable coating, as claimed, a cured coating overlaying a non-curable coating, as claimed, or an ink containing a photoinitiator, as claimed. The first defect is disputed by the Examiner. The second two defects are acknowledged by the Examiner who purports to cure them by combining the teachings of Wang with the respective teachings of Eby and Schmidle. The applicant respectively disagrees with the Examiner and with the Examiner's suggested combinations for the reasons provided below.

Wang discloses a transparent or translucent layer 24 overlying the transparent or translucent layer 16 but contains no disclosure whatsoever indicating that the transparent or translucent layer 16 is non-curable. The Examiner's assertions regarding the PVC plastisol of the second layer 66 and the wearlayer 24 do not relate to the question of whether the transparent or

translucent layer 16 is non-curable, as claimed. Moreover, the applicant notes that Wang describes the first layer containing platey material as being “hardenable,” which suggests that the transparent or translucent layer 16 is, in fact, curable in contrast with the claimed non-curability of the first coating of the claimed invention.

With this in mind, since neither Eby nor Schmidle is cited as providing the claimed first non-curable coating, the applicant respectfully asserts that claim 1 is patentably distinguished from any combination of the cited references and that, therefore, the rejection of claim 1 is traversed on that basis alone.

Furthermore, regarding the combination of Wang with Eby, the Examiner acknowledges that Wang fails to disclose a cured coating overlaying the “non-curable cured” coating (emphasis added) but suggests that Eby teaches a surface covering wherein a cured coating overlaying an ink is mechanically embossed and concludes that it would have been obvious to “include a cured coating overlaying the “non-cured” coating (emphasis added) of Wang...to further protect underlying layers.”

As an initial matter, the applicant disputes the Examiner’s statement of the claimed feature in question. By way of review, it is noted that claim 1 recites “applying a first, non-curable coating” and “applying a second, curable coating over said first coating (which is, as explained above, non-curable).” Thus, according to claim 1, the second curable coating is applied over a non-curable coating that is not and cannot be cured. This is clearly differentiated from the Examiner’s statement whereby the defect of Wang is characterized as being a failure to teach a cured coating overlaying a non-curable but somehow cured coating and places into question the remainder of the Examiner’s analysis of the issue since the claimed feature of a cured coating overlaying a non-curable coating is otherwise disregarded or improperly altered.

For example, in his conclusory statement in support of the suggested Wang/Eby combination, the Examiner states that it would have been obvious to “include a cured coating overlaying the non-cured coating (emphasis added) of Wang...to further protect underlying layers.” In doing so, the Examiner has apparently and improperly replaced the claimed phrase “non-curable” with the unclaimed phrase “non-cured.” Without addressing the merits of the

conclusion, then, the applicant respectfully asserts that, even if it would have been obvious to include a cured coating overlaying the non-cured Wang coating to further protect underlying layers, as suggested, the suggestion says absolutely nothing about including a cured coating overlaying a non-curable coating, as is actually claimed.

As a further matter, to whatever extent Eby discloses a surface covering wherein a cured coating overlaying an ink is mechanically embossed, as is suggested by the Examiner, the Examiner has not provided an explanation as to how such a disclosure relates to the actual defect of Wang (whether the defect relates to a failure to disclose a non-curable coating, a non-cured coating or a non-curable cured coating). That is, the Examiner has not indicated what relationship the Eby ink has to Wang's non-curable, non-cured or non-curable cured coating. If it is the Examiner's position that the Eby ink is comparable with the cured coating of Wang, it is clear that such a comparison is without merit since the items being compared are completely dissimilar. If, on the other hand, it is the Examiner's position that the Eby print layer B, which is formed with the retarder ink, is comparable with the cured coating of Wang, the applicants note that Eby is silent as to the print layer B being non-curable in which case the combination of Wang and Eby remains insufficient to establish a prima facie case of obviousness.

As a still further matter, the applicant notes that while the Examiner identifies claim 21 as a product by process, the Examiner still must identify elements in the cited references corresponding to all of the features of the claimed invention. Here, however, the Examiner has not put forward any evidence that Wang, Eby or Schmidle disclose jointly or separately the claimed activating of the photo-initiator or the claimed mechanical embossing of the second layer in areas not overlapping the printing ink.

Regarding the rejection of claim 22, the Examiner acknowledges Wang's failure to disclose a cured coating or cured layer overlaying the non-cured coating but purports to cure this defect by combining Wang's teachings with Eby's disclosure of a portion of the cured coating or layer overlaying an ink is chemically and/or mechanically embossed. The applicant respectfully disagrees with this combination.

In support of this position, the applicant reiterates many of the arguments made above

and further presents the following additional arguments. In Eby, a backing layer or substrate A is provided and a foamable layer C and D is formed on top of it. A design or print layer B is applied on the foamable layer and is formed with retarder ink. The wear layer is then applied on top of the design layer and cured. According to Eby, "[this] curing process will also chemically emboss areas of the design layer (see Eby, at column 3, lines 51-51)," which indicates that the design layer B is cured.

With this in mind, the applicant respectfully asserts that Eby fails to disclose a cured coating or cured layer overlaying the non-cured coating, which is precisely the defect of Wang purportedly being cured by the Wang/Eby combination. As such, since the additional citation to Schmidle does not cure this defect and is not even cited as doing so, the applicant submits that the suggested combinations fail to establish a prima facie case of obviousness.

Thus, the applicant respectfully asserts that claims 21 and 22 are both patentably distinguished from any combinations of the cited references and that, therefore, the rejections of these claims are believed to be traversed.

Regarding the rejections of claims 23-25, it is believed that the rejections of these claims are traversed for at least the reasons set forth above.

Newly added claim 26:

Claim 26 has been added is believed to be allowable for at least the reasons set forth above since claim 26 recites subject matter similar to that of claim 21 in slightly narrower language.

Conclusion:

It is believed that the foregoing amendments and remarks place the application in condition for allowance and an early and favorable action to that effect is respectfully requested.

The Examiner is invited to contact Applicants' attorney at the below listed phone number regarding this response or otherwise concerning the present application. Applicants hereby petition for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) which may be required for entry and consideration of the present Reply. If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,
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Date: August 2, 2010